

REMARKS

1. Introduction

This Amendment is filed in response to the Official Action dated December 28, 2004. In this Amendment, claims 1, 7 and 9-14 are amended and new claims 20-67 are added. Claims 1-67 are currently pending, of which claims 1, 10, 20, 28, 36, 44, 53 and 61 are independent.

2. Drawings

An objection to the drawings was lodged on grounds the element numbers and the figure labels should be thicker and clearer. In response, a full set of replacement drawings has been prepared and is submitted simultaneously with this response. Withdrawal of the objection is therefore requested.

3. Allowable Subject Matter

Claims 2, 5, 8, 11-12 and 14-17 were indicated as being allowable if rewritten in independent form. The Examiner is thanked for this indication and in accordance therewith, these allowable claims have been rewritten in independent form as follows: Claim 2 is rewritten as new independent claim 20; Claim 5 is rewritten as new independent claim 28; Claim 8 is rewritten as new independent claim 36; Claim 11 is rewritten as new independent claim 44; Claim 12 is rewritten as new independent claim 53; and Claim 14 is rewritten as new independent claim 61. Claims 15-17 were not rewritten in independent form as they depend from claim 14 which is already written in independent form as new claim 61.

In view of the Examiner's aforesaid indication of allowability, it is submitted that new independent claims 20, 28, 36, 44, 53 and 61 are now in condition for allowance. It is further submitted that new claims 21-27, 29-35, 37-43, 45-52, 54-60 and 62-67, which variously depend from these new independent claims are also in condition for allowance.

4. Prior Art Rejection Under 35 U.S.C. Section 102

Claims 1, 3, 4, 6, 7, 9, 10, 13 and 18-19 are rejected under 35 U.S.C. Section 102(b) based on U.S. Patent No. 5,891,457 to Neuwirth ("*Neuwirth*"). For at least the reasons stated below, this rejection is hereby traversed.

The present invention as recited in amended claim 1 is directed to a method of changing a gynecological condition of a female. Important steps in that method include the introduction of a pre-sterilized implant into the uterus followed by the maintaining of contact between the implant and the uterine tissue until the changed gynecological condition is caused.

This method contrasts considerably from the method depicted in *Neuwirth*. For example, *Neuwirth* simply does not disclose the use of an implant as recited in claim 1. Instead, *Neuwirth* discloses a method whereby a caustic liquid paste is injected from a syringe into the uterus followed by irrigation of that paste with another liquid substance that deactivates and irrigates the liquid paste. In short, the process in *Neuwirth* pertains exclusively to the use of liquid substances introduced into and then irrigated out of the uterus, not with an implant as in the invention recited in claim 1. Accordingly, the rejection of *Neuwirth* cannot be properly maintained.

However, to further clarify that the claimed invention pertains to method involving an implant and not to a method involving injection and irrigation of liquid substances as in *Neuwirth*, claim 1 has been amended. Amended claim 1 recites that the implant is introduced into the uterus with a delivery tool and that the implant is detached from the delivery tool after the implant is contacted with uterine tissue. Such steps are a further distinction from the method disclosed in *Neuwirth* thus further justifying the withdrawal of the rejection based on *Neuwirth*.

Similar observations are evident with respect to *Neuwirth* and amended independent claim 10. Although amended Claim 10 does not recite an implant, it does recite a self-contained presterilized substance. And since *Neuwirth* is directed to the use of liquid paste substances and liquid irrigation substances,

neither of which are self-contained, *Neuwirth* cannot be properly relied upon to reject amended claim 10. However, claim 10 has been further amended to indicate that the self-contained presterilized substance is disconnectable from a delivery tool. This aspect of the claimed invention further contrasts the invention of claim 10 from the liquid paste and liquid irrigation substances of *Neuwirth*.

As for dependent claims 2-8 and 11-20, these claims variously depend from independent claims 1 and 10 and are thus patentable for at least the same reasons set forth above. However, these dependent claims further define and describe the invention and are thus patentable over and above the patentability of their respective independent claims 1 and 10.

4. Prior Art Listing

Pursuant to MPEP § 609 I.A.2., the Applicant hereby submits with this Amendment a listing of the prior art that was considered in the parent application to the present application. This listing is provided to ensure that this prior art listing appears on the face of any patent to issue from the present application.

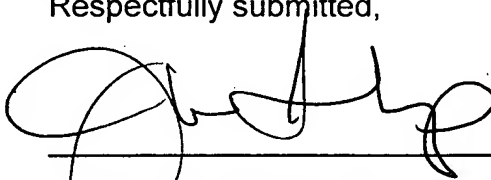
CONCLUSION

In view of the foregoing, it is submitted that all pending claims 1-67 are now in condition for allowance and an indication of such allowability is hereby requested. If after considering this amendment further issues or questions arise, the Examiner is cordially encouraged to contact the undersigned either via e-mail or by telephone according to the contact information set forth below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

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